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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,988	03/24/2004	Nobutaka Ukigaya	1232-5354	6780
27123	7590	01/10/2005		
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			EXAMINER THOMPSON, TIMOTHY J	
			ART UNIT 2873	PAPER NUMBER

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/808,988	Applicant(s) UKIGAYA, NOBUTAKA	
	Examiner Timothy J Thompson	Art Unit 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,3,6 and 7 is/are rejected.
- 7) ☒ Claim(s) 2, 4, 5 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/2004</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

Claim 5 is objected to because of the following informalities: claim 1 states that "a first electrode disposed at least between said partition wall and said first substrate" then claim 5 claims just the opposite of this limitation. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. (U.S. Pat. No. 6,828,955) in view of Wang et al. (U.S. Pat. Pub. No. 2004/0219306).

Regarding claim 1, Yamamoto et al. discloses a first substrate(fig 1, 2) and a second substrate(fig 1, 2) disposed opposite to each other with a spacing, a partition wall for dividing the spacing into a plurality of sections(fig 1, 20), a plurality of electrophoretic particles and an sections(fig 1, 22, 24), a first electrode(fig 1, 4) are disposed in the insulating liquid which disposed at least between said partition wall and said first substrate, and a second electrode(fig 1, 14) disposed on said second

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substrate. Yamamoto et al. does not disclose the first electrode has an adhesive property. However, Wang et al. discloses a first electrode has an adhesive property(the electrodes can be precoated with an adhesive layer para 0093 thus the electrode has an adhesive property). It would have been obvious to one skilled in the art at the time of the invention to precoat the electrode with an adhesive layer as shown by Wang et al., in the electrophoretic display of Yamamoto et al., since as shown by Wang et al. precoating the electrode with an adhesive is commonly done so as to provide a means for adhering the electrode to the electrophoretic structure.

Regarding claim 6, Yamamoto et al. discloses wherein the first electrode is an adhesive sheet disposed to cover the partition wall and the insulating liquid(fig 1).

Regarding claim 7, Yamamoto et al. discloses the Insulating liquid and the plurality of electrophoretic particles are encapsulated in a capsule and disposed in the spacing so that an outer wall of the capsule constitutes the partition wall(fig 1).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over a as applied to claim1 above, and further in view of Hoshikawa et al. (U.S. Pat. No. 4,640,583).

Regarding claim 3, Yamamoto et al., as detailed in claim rejection 1 above, does not discloses first substrate has a surface opposite to the first substrate and surface has been subjected to primer treatment. However, Hoshikawa et al. discloses first substrate has a surface opposite to the first substrate and surface has been subjected to primer treatment. It would have been obvious to one skilled in the art at the time of the

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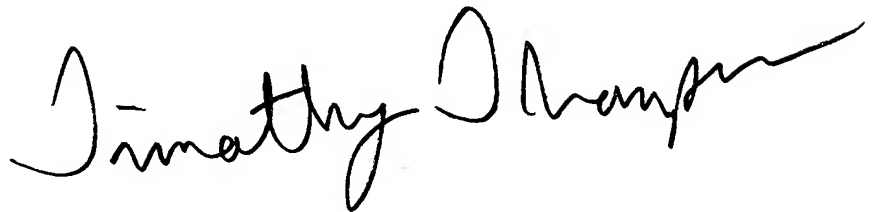
invention to use a primer layer on the substrate as shown by Hoshikawa et al., in the electrophoretic display of Yamamoto et al., since as shown by Hoshikawa et al. primer layers are commonly adhered to the surface of a substrate so as to increase the adhesion of the substrate to the opposing surface.

Allowable Subject Matter

Claims 2 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. With the allowable features being the specific materials used with the adhesive resin, the first substrate having recesses,

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Thompson whose telephone number is (571) 272-2342. If the examiner can not be reached his supervisor, Georgia Epps, can be reached on (571) 272-2328.

A handwritten signature in black ink, reading "Timothy J. Thompson". The signature is written in a cursive, flowing style with a long horizontal line extending from the end.

**TIMOTHY THOMPSON
PRIMARY EXAMINER**